

REMARKS

I. Introduction

Claims 1 and 5-12 are pending in the present application after cancellation of claims 2-4. Claims 1 and 5-9 have been amended. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1-12

Claims 1 and 3-12 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by United States Patent No. 6,302,190 ("Clamp"). In addition, claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,302,190 ("Clamp") in view of U.S. Patent 6,742,326 ("Xu"). Applicants note that the subject matters of claim 2-4, as well as additional features, have been incorporated into amended claim 1, and claims 2-4 have been canceled. In view of the amendments to claim 1 and the cancellation of claim 2-4, Applicants will address the combined teachings of Clamp and Xu as applied against remaining claims 1 and 5-12. For at least the following reasons, Applicants respectfully submit that pending claims 1 and 5-12 are patentable over the combination of Clamp and Xu.

To anticipate a claim under §102(b), each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). This teaching or suggestion to make the claimed

combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Amended claim 1 recites, in relevant parts, “a bottom section; a circuit board affixed on the bottom section; a cover affixed on the bottom section; and a cooling device . . . , wherein the cooling device is integrally formed in the bottom section, and wherein the bottom section is formed as a cooling plate that includes an integrated, one-piece cooling channel.” Applicants note that the amended features of claim 1 are fully supported by original claims 2-4 and original Specification, e.g., p. 2, l. 28 – p. 3, l. 11. In view of amended claim 1, which now recites at least three elements, i.e., bottom section, a circuit board, and a cover, Applicants respectfully submit that the embodiment shown in Figs. 8 and 9 (and described in col. 3, l. 1-33) of Clamp represents the closest embodiment to Applicants’ claimed invention. Even if this embodiment of Clamp may be construed as including a bottom section which is formed by the part denoted as “box 88,” Applicants note that this embodiment of Clamp has no circuit board affixed on bottom section 88, directly contrary to the claimed invention. Although Clamp mentions that an electronic control unit (ECU) is involved, no suggestion is made that this ECU has a circuit board, let alone any suggestion that a circuit board is affixed on the bottom section. Furthermore, Clamp clearly does not disclose or suggest that the cooling plate has “an integrated, one-piece cooling channel”; instead, the cooling channel in Clamp is made up of at least three parts, i.e., bottom section 88, seal 84, and “chill plate housing 76,” as well as further affixation arrangements (screws 72) which must be included, without which the cooling channel would not be sealable. In addition, the Xu reference clearly does not teach or suggest the above-recited features of amended claim 1.

For at least the foregoing reasons, Applicants submit that claim 1 and its dependent claims 5-12 are patentable over the combination of Clamp and Xu.

Independent of the above, Applicants note that claim 6 has been amended to explicitly recite that “the cooling channel is a linear cooling channel which passes through the bottom section in a linear manner.” Claim 6 is clearly patentable over the combination of Clamp and Xu, since the combination of Clamp and Xu does not show a linear cooling channel; instead, Clamp shows a U-shaped cooling channel.

CONCLUSION

It is respectfully submitted that all pending claims 1 and 5-12 of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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